

REMARKS

The present invention concerns compositions comprising at least one water-soluble or water-dispersible polymer; and at least one filler comprising WDP gypsum particles obtained from waste-gas desulphurization and having a mean particle diameter ranging from about 13 μm to 500 μm as determined by the Fraunhofer diffraction technique. The invention also concerns articles where these compositions are coated on a substrate. Use of the particular WDP gypsum particles described above, provide a product with superior properties such as, for example, decreased shrinkage.

Claims 12-41 are pending. Claims 31-41 are new. The basis for new claims 31 and 32 can be found, for example, at page 9, lines 21-30. The basis for new claims 33-41 can be found, for example, at page 14, lines 8-13 and in existing claims 12-20.

Claims 28 and 30 stand rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite. The basis of the rejection appears to be the number of articles made by Applicant's process. A claim can be directed to more than one article, certainly, when as here, the kinds of articles have a common element. In the previous Office Action, Applicants asked that if the Examiner was aware of contrary authority, that it be cited in support of the rejection. Applicants renew that request.

In regard to the question concerning the commonality of process between the articles, each article shares the common method recited in the claim in its manufacture. As such, Applicants believe that the claim is proper. Reconsideration and withdrawal of the rejection is respectfully requested.

Claims 12-30 stand rejected under 35 U.S.C. § 103 (a) as allegedly obvious in view of U.S. Patent No. 6,229,970 ("the Richards patent"). Applicants traverse this rejection because the Office has not established a *prima facie* case. The rejection is apparently based on the assumption that the gypsum of the present invention is produced by the same process of that in the Richards patent. It is not known, however, what particle size gypsum was used in the Richards patent. Applicants note that, as taught at page 8, line 27 to page 9, line 3 of the instant application, WDP gypsum particles of differing dimensions are formed by different waste-gas desulfurization processes. Nothing in the Richards patent suggests or appreciates

the advantages of the particle size of the instant invention. As such, it would not be obvious to one skilled in the art to select the instant particle size from the many possibilities.

In response to our previous arguments, the Office Action presents U.S. Patent No. 5,169,617 ("the Clemmens patent") to allege that flu-gas desulfurization gypsum particles are necessarily 200 microns or less (Final Rejection at page 3). That such particles or the Clemmens patent may overlap with the particles of the instantly claimed invention, does demonstrate that the particles of the Richardson patent are the same as those used in the claimed invention. The process of the Clemmens patent merely requires use of flu-gas desulfurization gypsum particles that are 200 microns or less (see, for example, col. 2, ll 34-40). It does not teach, however, that flu-gas desulfurization gypsum particles are necessarily 200 microns or less. As discussed above, different processes can produce particles of different sizes.

In the Advisory Action, the Examiner asserts that Applicants "have not demonstrated by factual evidence that the flu-gas desulfurization process would not be expected to produce applicant's claimed particle size." Applicants respectfully note that the MPEP §2142 states:

The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. *If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness.* ...The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must *expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning* as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references."

(emphasis added). As discussed above, the cited art does not teach, or fairly suggest Applicant's claimed particle size. Furthermore, as discussed above, there is no convincing evidence that such a property is inherent in the particles of the Richards patent. Thus, Applicants do not believe that a burden to produce such evidence has shifted to the Applicants. For at least this reason, Applicants request reconsideration and withdrawal of the rejection.

To further support the position that the instantly claimed invention is not obvious in view of the cited art, Applicants note that the instant compositions show an unexpected

DOCKET NO.: H3497 PCTUS/HENK-0016
Application No.: 09/856,236
Office Action Dated: January 8, 2004

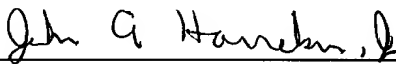
**PATENT
REPLY FILED UNDER EXPEDITED
PROCEDURE PURSUANT TO
37 CFR § 1.116**

advantage of decreased shrinkage that is not taught or suggested by the art. See Example 2 on pages 15-16 of the instant application. No such guidance is found in the Richards patent.

Applicants believe that the foregoing constitutes a complete and full response to the Office Action of record. Accordingly, an early and favorable reconsideration of the rejections and an allowance of all of pending claims is earnestly solicited.

Respectfully submitted,

Date: August 6, 2004



John A. Harrelson, Jr.
Registration No. 42,637

Woodcock Washburn LLP
One Liberty Place - 46th Floor
Philadelphia PA 19103
Telephone: (215) 568-3100
Facsimile: (215) 568-3439